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## Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>*17 December 2008*</u>.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,11,13-16 and 20-22* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,11,13-16 and 20-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection.  Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114.  Applicant's submission filed on 17 December 2008 has been entered.

### *Response to Amendment*

The amendment filed 1 December 2008 has been entered.  Claims 1, 11, 13-16, and 20-

22 are pending.  Claims 1 and 15 are currently amended.  No claims are new.  Claims 2-10, 12,

17-19, and 23-45 are cancelled.  This action is NON-FINAL.

### *Claim Objections*

As per claim 15, there should be a comma after the phrase "an author of the unrestricted

portion" in the step of "collecting."

### *Claim Rejections - 35 USC § 112, Second Paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claim1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Claim 1 is indefinite because the steps of "receiving," "interrogating," and "collecting"

are unclear. The step of "collecting the content object... responsive to the request" implies that

the method receives a request for a content object and interrogates a plurality of content sources

to retrieve the content object. That is what the specification describes, but limitations from the

specification are not read into the claims. Thus, it is unclear from where the "content object...

responsive to the request" is coming and how the steps of "receiving" and "interrogating" are

related to the rest of the steps.

Further, the claim is indefinite because the method interrogates a plurality of content

sources (presumably to retrieve a content object) but then collects the content object from the

federated repository. It is unclear why the method interrogates a plurality of content sources but

collects the content object from the federated repository. From the specification, it appears that

the "federated content repository" comprises the "plurality of content sources." Limitations from

the specification are not read into the claims, however.

### Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-16 and 20-22 rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

The process of claims 15-16 and 20-22 is not statutory because abstract ideas alone are not patentable. To be patentable, a process must have a practical application and (1) be tied to a particular machine or (2) transform a particular article into a different state. *In re Comiskey*, 499 F.3d 1365, 1376-77 (Fed. Cir. 2007); *In re Bilski*, __ F.3d __ (Fed. Cir. 2008).

An algorithm that is only useful in connection with a computer is still not "tied" to a machine. *Gottschalk v. Benson*, 409 U.S. 63, 64, 71-72 (A method of converting binary-coded decimal numerals into pure binary numerals was "not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use" and would "wholly preempt the mathematical formula and in practical effect would be a patent on the algorithm itself"). Rather, a claim reciting an algorithm is statutory only if, as employed in the process, "it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e., a machine, manufacture, or composition of matter." *In re Comiskey*, 499 F.3d at 1376.

Here, the method preempts an abstract idea because it could be performed by a human entirely on paper. The limitation "collecting a content object responsive to a request by a collection function on a server" does not sufficiently tie the method to a particular machine because the "collection function" does not perform any method steps; rather, it requests that whatever is performing the method (e.g. a human) do something.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohrer et al., U.S. 2003/0088520 ("Bohrer"), in view of Kohane et al., U.S. 2004/0199765 ("Kohane").

1. Bohrer teaches "*A method for managing privacy preferences or access to restricted information, comprising,*" see par. 1, "methods, systems and business methods to enforce privacy preferences on exchanges of personal data across a network."

Bohrer teaches "*tagging restricted or personal information in a content object to distinguish the restricted or personal information from an unrestricted portion of the object content,*" see Fig. 2 and par. 45, "The Authorization Dataset in a rule contains the data items that can be released according to the rule. Each authorization data set can be either a View Level 205... Moreover, a data subject can categorize his/her personal data into multiple View Levels (layers) so that the data in each View Level have the same privacy preference, access and authorization constraints, whereas data in different View Levels have different constraints" where the claimed "content object" is the referenced "authorization rule 201" and the claimed "tagging restricted or personal information" is the referenced user categorization of personal data into "View Levels."

Bohrer teaches "*storing the content object in a federated content repository,*" see par. 17, "it allows a data subject to express complex policies on a large set of personal data in a way that is applicable regardless of the specific representation and data model used by enterprises that store that data."

Bohrer teaches *"storing the personal identification information of the author in a separate storage device from the federated content repository,"* see Fig. 1 and par. 33, "To facilitate the requests from a Data Subject to setup data profiles and privacy policies... The profiles are stored in a Profile Database 123 while the policies are stored in a Policy Database 124."

Bohrer teaches *"receiving a request by a collection function on a server,"* see par. 32, "a Data Requester 105 can use a web browser 106 or some other computer programs 107 to send requests for data."

Bohrer teaches *"interrogating a plurality of content sources remote from the server by the collection function to satisfy the request,"* see par. 35, "The Profile Responder 116 receives requests for profile information... and uses the Policy authorization engine to check the authorization and privacy policies."

Bohrer teaches *"collecting the content object from the federated content repository in response to the content object being responsive to the request,"* see par. 16, "The data is released only if the privacy declaration of the requester matches the constraints imposed by the data subject via its privacy preferences."

Bohrer teaches *"distributing the content object to a privacy function on the server,"* see par. 30, "This embodiment supports the enforcement of privacy preferences in data exchanges according to authorization checks based on the privacy preferences specified by a data subject with the privacy policies of a data requester" where the referenced "authorization checks" are the claimed "privacy functions."

Bohrer teaches *"comparing the privacy preferences or other restriction preferences of the author of the content object to policies of a content provider by a compare function of the privacy function,"* see Fig. 5 and par. 82, "For each data item name in the query and in the request item list, the Policy Authorization Engine retrieves any privacy preferences from the authorization rules. It then performs the Policy-Preference matching process (see FIG. 6) for each data item" and par. 5, "the products listed here focus on allowing a complex privacy policy to be represented and checked against either a web site's privacy policy or a data requester's privacy policy" where the claimed "content provider" is the referenced "web site's privacy policy or a data requester's privacy policy."

Bohrer teaches *"and distributing the content object based on the privacy preferences or other restriction preferences,"* see Fig. 4b and par. 81, "A data response is... the subset of specific data items which were requested and authorized, along with associated privacy declarations representing the data subject's privacy preferences."

Bohrer does not teach *"defining the content object to include the unrestricted portion of the object content in a mark-up language and a link to the restricted or personal information... and wherein the restricted information comprises personal identification information of the author."* Kohane does, however, see Figs. 3-4, par. 37, "A record is an integrated collection of information concerning a particular individual or entity. That particular individual (or entity) is the record owner. The creator of the record, hereafter called the record author, can be the record owner," pars. 40, "the information about the record owner in the record is embodied in record objects," par. 67, "The Data section 68 can contain zero or more record objects, denoted by '(Record-object*)' and includes two attributes, 'type' and 'URL.' In one embodiment, the data

section 68 either includes the record data internally or references an external location from which the data can be obtained," and par. 103, "For example, the record owner can place personal identification information within one record object," where the claimed "content object" is the referenced "record," the claimed "unrestricted portion" is the referenced internal "record data," the claimed "link" is the referenced reference to "an external location," and the claimed "restricted information" is the referenced "information about the record owner." While Kohane does not explicitly teach "*wherein the content object comprises one of a white paper, a case study, a press release, and an article by an author, wherein the unrestricted portion of the content object includes a title, an abstract, and a description*," it would be obvious for the record to contain at least a white paper since they are generally confidential, see par. 37, "In other embodiments, the record can include other types of personal or confidential information, such as financial data, legal data, etc." Thus, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the teachings of the cited references because Kohane's teachings would have allowed Bohrer's method to give a third party access to the record without revealing the identity of the author, see par. 102.

Bohrer does not explicitly teach "*parsing the content object by the privacy function to provide access to the privacy preferences or other restriction preferences of the author of the content object in response to the content object being collected to satisfy the request.*" Kohane does, however, see par. 103, "Consequently, when the research institution accesses the record of the record owner, the gateway server system 22 parses through the associated directory file and skips over those record objects for which the research institution is unauthorized" and par. 83, "The gateway server system 22 parses (step 104) through the directory file to determine those

record objects that the accessing agent can manipulate according to the specified record operation." Thus, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the teachings of the cited references because Kohane's teachings would have allowed Bohrer's method to give a third party access to the record without revealing the identity of the author, see par. 102. Bohrer does teach "*wherein the privacy preferences or other restriction preferences are remote from the server and are accessed by the link*," see Fig. 1 and par. 32, "Similarly, a Data Requester 105 can use a web browser 106 or some other computer programs 107 to send requests for data 109 as well as receive replies 110 to that request along with any returned data."

11. Bohrer teaches "*The method of claim 1, further comprising locating or accessing privacy preferences or other restriction preferences using another link*," see Fig. 1 and par. 32, "Similarly, a Data Requester 105 can use a web browser 106 or some other computer programs 107 to send requests for data 109 as well as receive replies 110 to that request along with any returned data."

13. Bohrer teaches "*The method of claim 1, further comprising distributing the content object to a requester without any modification to the content object in response to the privacy preferences or other restriction preferences of the author or owner of the content object being consistent with the content provider's policies*," see par. 17, "an independent third party acting as a data-subject's personal data service and providing various services including... matching privacy policies, gathering data from third parties and releasing and/or authorizing release of data to data requesters."

14. Bohrer teaches "*The method of claim 1, further comprising: deleting or replacing the restricted or personal information with default or generic information in response to the privacy preferences or other restriction preferences of the author or owner of the content object being inconsistent with the content provider's policies*," see par. 81, "A data response is either a denial, if the request cannot be fulfilled, or the subset of specific data items which were requested and authorized" and Fig. 5 where, see par. 82, "If the result is deny, then the data item is not included in the list of data items to be returned in the response 511" where the claimed "deleting" is the referenced data "not included" in the response.

Bohrer teaches "*repackaging the content object in response to deleting or replacing the restricted or personal information,*" see Fig. 5 and par. 82, "When the entire request list has been processed, the data to be returned is gathered 516."

Bohrer teaches "*and distributing the repacked content object to a requester without the restricted or personal information which has been deleted ore replaced by the default or generic information,*" see Fig. 5 and par. 82, "the response structure is constructed and returned to the requester by the Profile Responder 517."

Claims 15-16 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohrer et al., U.S. 2003/0088520 ("Bohrer"), in view of Fahlman et al., U.S. 5,960,080 ("Fahlman"), and further in view of Kohane et al., U.S. 2004/0199765 ("Kohane").

15. Bohrer teaches "*A method for managing privacy or access to restricted information, comprising,*" see par. 1, "methods, systems and business methods to enforce privacy preferences on exchanges of personal data across a network."

Bohrer teaches *"collecting a content object responsive to a request by a collection function on a server,"* see Fig. 5 and par. 82, "If authentication succeeds, then the data request is passed to the Policy Authorization Engine which retrieves all Authorization Rules of the data subject specified in the request 503." Bohrer does not teach *"wherein the content object includes an unrestricted portion and a link to restricted personal identification information of an author of the unrestricted portion."* Kohane does, however, see Figs. 3-4, par. 37, "A record is an integrated collection of information concerning a particular individual or entity. That particular individual (or entity) is the record owner. The creator of the record, hereafter called the record author, can be the record owner," pars. 40, "the information about the record owner in the record is embodied in record objects," par. 67, "The Data section 68 can contain zero or more record objects, denoted by '(Record-object*)' and includes two attributes, 'type' and 'URL.' In one embodiment, the data section 68 either includes the record data internally or references an external location from which the data can be obtained," and par. 103, "For example, the record owner can place personal identification information within one record object," where the claimed "content object" is the referenced "record," the claimed "unrestricted portion" is the referenced internal "record data," the claimed "link" is the referenced reference to "an external location," and the claimed "restricted... information" is the referenced "information about the record owner." Bohrer also does not teach *"wherein the content object is stored in a federated content repository and the restricted personal identification information of the author of the unrestricted portion of the content object is stored in a separate storage device from the federated content repository."* Kohane, does, however, see Fig. 1, par. 32, "In one embodiment, the agent system 26 is a computer system that is in communication with one or more legacy data systems 34a and

34b (collectively 34) over a network 30. For example, the legacy data systems 34 can be

databases containing confidential records maintained by independent institutions such as

hospitals, financial, and legal institutions," and par. 39, "When the record owner initially

connects to the gateway server system 22 (using the agent system 14, 18, or 26), the record

owner can control the server 18 upon which the record is stored as an XML directory file,"

where the claimed "server" is the referenced "server system 22," the claimed "federated content

repository" is the referenced "server 18," and the claimed "separate storage device" is the

referenced "legacy data systems 34a and 34b." Thus, it would have been obvious to one of

ordinary skill in the database art at the time of the invention to combine the teachings of the cited

references because Kohane's teachings would have allowed Bohrer's method to gain access to

confidential records over a network, see par. 5.

Bohrer teaches "*accessing privacy preferences or other restriction preferences of the*

*author of the unrestricted portion of the content object, wherein the privacy preferences or other*

*restriction preferences are remote from the server*," see Fig. 5 and par. 82, "the Policy

Authorization Engine next compares the privacy declarations in the request with the Privacy

Preference Rules in the authorization rules for each profile data item name in the request item

506."

Bohrer teaches "*comparing the privacy preferences or other restriction preferences of the*

*author of the unrestricted portion of the content object to a content provider's policies*," see Fig.

5 and par. 82, "For each data item name in the query and in the request item list, the Policy

Authorization Engine retrieves any privacy preferences from the authorization rules. It then

performs the Policy-Preference matching process (see FIG. 6) for each data item" and par. 5,

"the products listed here focus on allowing a complex privacy policy to be represented and checked against either a web site's privacy policy or a data requester's privacy policy" where the claimed "content provider" is the referenced "web site's privacy policy or a data requester's privacy policy."

Bohrer teaches "*[deleting] private or restricted information… in response to the privacy preferences or other restriction preferences being inconsistent with the content provider's policies, wherein the content provider collects the content object and has access to the private or restricted information*," see Figs. 4-5, 7, par. 81, "A data response is either a denial, if the request cannot be fulfilled, or the subset of specific data items which were requested and authorized," par. 82, "If the result is deny, then the data item is not included in the list of data items to be returned in the response 511" and par. 88, "**FIG. 7** is a flow diagram of a routine that enables a gather and filtering process carried out to collect data to be returned to a data requester," where the claimed "deleting" is the referenced data "not included" in the response. Bohrer does not teach "*replacing private or restricted information with default or generic information.*" Fahlman does, however, see Fig. 1 and col. 3, lines 48-53, "In step 105, the identified sensitive terms are replaced with standard tokens. For example, the sensitive term 'Mr. Johnson' is replaced by the standard token <person-1>, and the term 'Jul. 1, 1997' is replaced by <date-1>." Thus, it would have been obvious to one of ordinary skill in the database art at the time of the invention to combine the teachings of the cited references because Fahlman's teachings would have allowed Bohrer's method to grant access to an untrusted source without compromising confidentiality, see col. 1, line 66 – col. 2, line 3.

Bohrer teaches "*repackaging the content object in response to replacing the private or restricted information*," see Fig. 5 and par. 82, "When the entire request list has been processed, the data to be returned is gathered 516."

Bohrer teaches "*and distributing the repackaged content object to a requester without the private or restricted information*," see Fig. 5 and par. 82, "the response structure is constructed and returned to the requester by the Profile Responder 517."

16. Bohrer teaches "*The method of claim 15, further comprising distributing the content object as originally constituted in response to the privacy preferences or other restriction preferences being consistent with the content provider's policies*," see par. 33, "To facilitate the requests… for data from Data Requesters, the system must provide several different functionalities, including the ability to… authorize release of data based on authorization rules and privacy policy matching and release data."

20. Bohrer teaches "*The method of claim 15, further comprising distributing any content object in response to the request to a privacy function*," see par. 30, "This embodiment supports the enforcement of privacy preferences in data exchanges according to authorization checks based on the privacy preferences specified by a data subject with the privacy policies of a data requester' where the 'authorization checks' are considered 'privacy functions.'"

21. Bohrer teaches "*The method of claim 20, further comprising parsing the content object to provide access to privacy preferences or other restriction preferences*," see par. 44, "In other words, an Authorization Rule declares that for a specified Authorization Dataset, the specified Privacy Preference Rule is applied for the specified Access List to determine an Authorization Action" and par. 46, "The Access List in a rule declares who can access the

specified data set upon Privacy Preference matching" where in order to apply the referenced

"Privacy Preference Rule" to the "Access List," the "Privacy Preference Rule" must be "parsed."

      22. Bohrer teaches *"The method of claim 21, further comprising locating or accessing the*

*privacy preferences or restriction preferences using a link,"* see Fig. 1 where, see par. 32,

"Similarly, a Data Requester 105 can use a web browser 106 or some other computer programs

107 to send requests for data 109 as well as receive replies 110 to that request along with any

returned data."


### *Response to Arguments*

      As per Applicant's argument that Kohane does not teach *"defining the content object to*

*include the unrestricted portion of the object content in a mark-up language and a link to the*

*restricted or personal information,"* the Examiner respectively disagrees.  In order to clarify the

previous rejection, the Examiner has cited Figs. 3-4, par. 37, "A record is an integrated collection

of information concerning a particular individual or entity. That particular individual (or entity)

is the record owner. The creator of the record, hereafter called the record author, can be the

record owner," pars. 40, "the information about the record owner in the record is embodied in

record objects," par. 67, "The Data section 68 can contain zero or more record objects, denoted

by '(Record-object*)' and includes two attributes, 'type' and 'URL.' In one embodiment, the

data section 68 either includes the record data internally or references an external location from

which the data can be obtained," and par. 103, "For example, the record owner can place

personal identification information within one record object," where the claimed "content object"

is the referenced "record," the claimed "unrestricted portion" is the referenced internal "record

data," the claimed "link" is the referenced reference to "an external location," and the claimed

"restricted information" is the referenced "information about the record owner."

As shown in Figs. 3-4 and described in at least the cited paragraphs, Kohane's "records"

include internal data and/or links (URL's) to "record-objects." An author/owner's personal

information is stored in one or more record-objects linked to the record. The internal data, data

objects with full privileges granted to all roles, and/or all information in the record other than the

record-objects is "unrestricted." Thus, Kohane teaches a mark-up language content object that

includes an unrestricted portion of content and a link to the restricted/personal information.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Aaron Sanders whose telephone number is 571-270-1016. The

examiner can normally be reached on M-F 9:00a-4:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo can be reached on 571-272-3642. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/Tim T. Vo/
Supervisory Patent Examiner, Art Unit
2168


/Aaron Sanders/
Examiner, Art Unit 2168
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